

Application No. 09/744,678
Art Unit 1616
January 22, 2004
Reply to Office Action of August 25, 2003

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

In the present amendment, claims 2 and 9 have been canceled and claims 32-34 have been added. Claims 1, 6, 7, 16-18, 20, 30, 31 have been amended. Thus, claims 1, 6-8, 13-20 and 27-34 are pending in the present application.

No new matter has been added by way of these amendments and new claims, because each amendment and new claim is supported by the present specification. For example, the amendment to claim 1 merely incorporates the subject matter of canceled claims 2 and 9, and is further supported in the specification at page 3, lines 5-9; page 7, lines 17-22; and page 13, lines 7-8. The amendments to claims 6-7 are obviously editorial in nature and are not narrowing in scope. Claim 17 has been amended to properly depend on claim 1. This is a clarifying and not a narrowing amendment. Claims 16, 18, 20, 30 and 31 have been amended into independent form by incorporating the subject matter of claim 1. The specification at pages 3-4 also supports these amendments. New claim 32 is supported in the specification at page 4, lines 9-15. New claim 33 has support in the paragraph bridging pages 2-3; page 4, lines 9-15; and page 7, lines

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

1-22. New claim 34 has support in the specification at page 7, lines 17-22. Thus, no new matter has been added.

The amendment to the specification at page 7 was made since a gibberellin is not a brassinosteroid. No new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 112, Second Paragraph

Claims 6, 7, 27 and 28 stand rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness. Applicants respectfully traverse.

As shown in claim 6, an effective amount of the plant freshness-keeping composition is being applied to the plant. Further, claim 7 is directed to a method of preserving a plant. Thus, Applicants respectfully submit that the disputed claims fully comply with the provisions of 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of this rejection are respectfully requested.

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

Issues Under 35 U.S.C. § 102(b)

Claims 1, 8 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP '010 (JP Publication No. JP 54020010 A). Also, claims 1, 15, 17 and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP '856 (JP Publication No. JP 07291856 A). In addition, claims 1, 14 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP '707 (JP Publication No. JP 55083707 A). Further, claims 1, 13 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP '185 (JP Publication No. JP 59189185 A). Finally, claims 1, 6, 7, 9, 17, 27 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP '801 (JP Publication No. JP 02209801 A). Applicants respectfully traverse each of these rejections, and reconsideration and withdrawal of all rejections are respectfully requested.

Each Japanese reference is asserted to disclose certain ingredients. However, Applicants respectfully submit that each cited reference fails to disclose all features as instantly claimed as follows.

JP '010

The cited JP '010 reference is directed to a sweetening composition that exhibits "excellent whipping property and sweetness" and suitable for use in butter cream. However, Applicants

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

respectfully submit that JP '010 fails to disclose the features of instantly pending claim 1 (as well as claims 8 and 17, which are at issue here), such as the ratio between components (A) and (B). JP '010 is even directed to a food product, and not to treat plants. Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited JP '010 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed (i.e., ratio between (A)/(B)), the rejection in view of JP '010 is overcome. Also, since claim 8 and 17 depend on claim 1, Applicants respectfully submit the rejection of these claims is also overcome. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

JP '856

The cited JP '856 reference fails to disclose the features of instantly pending claim 1 (as well as the features of dependent claims 15, 17 and 29, which are at issue here), such as the ratio between components (A) and (F). Instead, JP '856 is directed to a skin disease-treating medicine (i.e., to treat senile xeroderma)

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

having a moisturizing agent, wherein any asserted ratio between (A) and (F) and the amount of (F) is outside what is instantly claimed (i.e., 3 to 15% of (F) in the reference). There is no disclosure of all features in JP '856 as instantly recited in the disputed claims. Thus, under *Verdegaal Bros.*, this rejection is overcome since there is a lack of disclosure of all claimed features.

JP '707

The cited JP '707 reference is directed to a cosmetic composition having a skin-protective effect. The composition in JP '707 can be used for handcreams or milk-cosmetics. However, JP '707 fails to disclose the features of instantly pending claims 1, 14 and 17 (i.e., such as the ratio between components (A) and (E); the amount of (A) in the cited reference is outside of what is instantly claimed).

Further, with respect to the disclosure in JP '707 for a "polyvalent metal salt (V) of fatty acid", component (E) of the present invention is not directed to any such component, including a calcium or magnesium salt of fatty acid.

Applicants also point out that "polyoxyethylene sorbitol fatty acid ester" is disclosed in JP '707, and not "sorbitol fatty acid ester" as stated in the Office Action. Thus, under *Verdegaal Bros.*, this rejection of instantly pending claims 1, 14 and 17 is overcome

Application No. 09/744,678
Art Unit 1616
January 22, 2004
Reply to Office Action of August 25, 2003

since there is a lack of disclosure of all claimed features. Reconsideration and withdrawal of this rejection are respectfully requested.

JP '185

The cited JP '185 reference is directed to a water-treatment composition. However, not only does the composition of JP '185 have a different usage than the present invention, this reference fails to disclose the features of instantly pending claims 1, 13 and 17 (i.e., the ratio between components (A) and (D)). In fact, component (D) of the present invention does not encompass the semicarbazide hydrochloride as disclosed in JP '185. Therefore, under *Verdegaal Bros.*, this rejection is overcome since there is a lack of disclosure of all claimed features.

JP '801

The cited JP '801 reference is asserted to disclose a composition that is applied to plants, etc. (at page 3 of the Office Action). However, Applicants respectfully submit that JP '801 fails to disclose the features of the disputed claims, such as the ratio between components (A) and (C)). In fact, component (C) of the present invention is not even disclosed by JP '801 (see claim 1). Applicants also point out that polyoxyethylene sorbitol fatty acid

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

ester is disclosed in JP '801, and not sorbitol fatty acid ester as stated in the Office Action. In addition, the composition of JP '801 is different from the present invention since it actually has an opposite function versus the composition of the present invention (i.e., enhancing versus retarding plant growth and maintaining freshness). Thus, under *Verdegaal Bros.*, this rejection is overcome due to the lack of disclosure of all claimed features. Reconsideration and withdrawal are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 2, 19 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '801 as previously applied, as being unpatentable over JP '185 as previously applied, as being unpatentable over JP '707 as previously applied, or as being unpatentable over JP '010 as previously applied. Further, claims 2 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '856 as previously applied. Applicants respectfully traverse based on the following remarks.

Each of the cited references fails to disclose certain amounts and ratios of the components as instantly claimed. Essentially, each of the mentioned rejections is based on how it would be obvious for one of ordinary skill in the art to account for such claimed features. However, Applicants respectfully traverse.

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

Each of the cited references have different uses, making such rejections improper. For instance, one of ordinary skill in the art would not "optimize" any amount when JP '856 discloses ingredients useful to treat itchy skin. This is on top of the fact that JP '856 discloses using other components that would be beneficial to treat such skin disorders. As another example, JP '707 teaches a composition useful for cosmetics, which is not an analogous art to the present invention. If anything, varying the amounts and ratios of the components of these references in order to achieve the present invention may make these references inoperable.

Thus, the requisite motivation and reasonable expectation of success are lacking. There are three possible sources of motivation to combine references: the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Here, the nature of the problem varies, ranging from treating skin disorders to preventing plant growth. Further, the teachings of these references are such that they are not within a field of endeavor that is related to the present invention. One having ordinary skill in the art, faced with the problem of keeping the freshness of a plant, would not refer to any of the cited Japanese references when seeking a solution. Even if these references were somehow considered, one having ordinary skill in the art would

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

not know how to proceed since the reference are completely silent about treating plants. Thus, the skilled artisan would never refer to such references when they are in a non-analogous field. With respect to JP '801, Applicants note that this reference does not disclose components (A) and (C) as instantly claimed (the other requirement for a *prima facie* case of obviousness). Thus, Applicants respectfully submit that the cited references have been improperly modified in order to achieve the present invention.

Applicants further submit that while a reference need not expressly teach that the disclosure contained therein should be combined with another, see *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combining references "must be clear and particular". See *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here, there is no clear and particular guidance in any of the cited references to achieve the formulations as presently claimed. The references merely disclose ingredients useful to make a cosmetic or butter cream with better whipping properties.

With regard to JP '801, this reference fails to disclose the components as instantly claimed. Thus, not even the requirement of disclosure of all claimed features is met to form a *prima facie* case of obviousness. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438,

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

Thus, Applicants respectfully submit that impermissible hindsight reconstruction has been applied when asserting that the disclosure of the cited references equals the present invention. Applicants submit that "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." *Orthopedic Equip. Co., Inc. et al. v. United States*, 217 USPQ 193, 199 (Fed. Cir. 1983). Accordingly, Applicants respectfully request the Examiner to reconsider, and to withdraw all rejections and allow the currently pending claims.

Allowable Subject Matter

Claims 16, 18, 20, 30 and 31 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully refer the Examiner to these allowed claims, which are now in proper independent form. Accordingly, Applicants respectfully request a declaration of allowable subject matter for at least the mentioned claims. Applicants also request consideration of all other pending claims.

Application No. 09/744,678

Art Unit 1616

January 22, 2004

Reply to Office Action of August 25, 2003

Conclusion

Applicants respectfully submit that the present invention is patentably distinct over the cited references, and the modifications thereof. Further, Applicants submit that the claims recite clear and definite claim language, so that there remain no other outstanding issues.

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition for two (2) months extension of time for filing a response in connection with the present application. The required fee of \$420.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

Application No. 09/744,678

Art Unit 1616

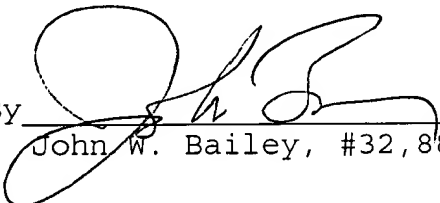
January 22, 2004

Reply to Office Action of August 25, 2003

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
John W. Bailey, #32,881

⁴
JWB/ETP
0425-0821P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

(Rev. 09/30/03)